



10/081170

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Yoshihiro Kawaoka et al.

Examiner: Sarvamangala Devi

Serial No.: 10/081170

Group Art Unit: 1645

Filed: February 22, 2002

Docket: 800.029US1

Title: METHODS TO IDENTIFY MUTANT CELLS WITH ALTERED SIALIC ACID

RESPONSE TO RESTRICTION REQUIREMENT

RECEIVED
OCT 17 2003
TECH CENTER 1600 2300

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Restriction Requirement mailed September 10, 2003, Applicant provisionally elects, with traverse, the claims of Group I (claims 1-11), directed to an isolated mutant cell comprising decreased levels of sialic acid containing host cell receptors for influenza virus relative to a corresponding wild-type cell which supports efficient influenza virus replication. Reconsideration and withdrawal of the Restriction Requirement, in view of the remarks herein, is respectfully requested.

The Restriction Requirement is traversed on the basis that the inventions are closely related. Claims directed to an isolated mutant cell comprising decreased levels of sialic acid containing host cell receptors for influenza virus relative to a corresponding wild-type cell which supports efficient influenza virus replication (claims 1-11; Group I) are clearly closely related to a method of isolating (i.e., making) a cell that has decreased levels of sialic acid binding lectin or sialic acid binding agglutinin (claims 12-21; Group II) and claims directed to a lectin-resistant or agglutinin-resistant cell isolated by the method (claims 22-24; Group III); claims directed to a method of propagating influenza virus having reduced sialidase activity which employs the mutant cell of the invention (claims 25-26; Group IV) or a lectin-resistant or agglutinin-resistant cell of the invention (claims 25-26; Group V); and claims directed to a method of using the mutant cell of the invention (claims 27-31; Group VI) or the lectin-resistant or agglutinin-resistant cell of the invention (claims 27-31; Group VII).

In particular, claims directed to a mutant cell of the invention (claims 1-11; Group I) are quite related to a method of making those cells (claims 12-21; Group II) and a method of using those cells (claims 25-26, Group IV; and claims 27-31, Group VI) those cells.

The Restriction Requirement is also traversed on the basis that Restriction Requirements

are optional in all cases. M.P.E.P. § 803. If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it arguably may include claims to distinct or independent inventions. M.P.E.P. § 803. Moreover, it is submitted that Applicant should not be required to incur the additional costs associated with the filing of multiple divisional applications in order to obtain protection for the claimed subject matter. For instance, due to the relatedness of at least the claims in Group I, II, IV and VI, the claims in Groups I, II, IV and VI can be efficiently and effectively searched in a single search with no additional burden placed on the Examiner. Evidence that the claims in at least Groups I, II, IV and VI can be efficiently and effectively searched in a single search with no additional burden placed on the Examiner is provided in the Restriction Requirement as those claims are in the same class (class 435) for search purposes.

Further, as claims 25 and 27 are linking claims for claims in Groups I, IV and VI, claims 1-11 and 25-31, as the latter depend on claim 1, should be examined in the same application. M.P.E.P. 809.03.

In the event the Examiner does not examine claims 25-31 with the claims in Group I, Applicant's Representatives respectfully request rejoinder of the claims in at least Groups IV and VI with the claims in Group I upon a notice of allowance for the claims in Group I. M.P.E.P. 821.04.

Thus, the Restriction Requirement is properly traversed. Accordingly, reconsideration and withdrawal of the Restriction Requirement is respectfully requested.

RESPONSE TO RESTRICTION REQUIREMENT

Serial Number: 10/081170

Filing Date: February 22, 2002

Title: METHODS TO IDENTIFY MUTANT CELLS WITH ALTERED SIALIC ACID

Page 3

Dkt: 800.029US1

Conclusion

Applicant respectfully requests a favorable examination of the merits of this patent application. The Examiner is invited to telephone Applicant's attorney (612-373-6959) to facilitate prosecution of this application. Please charge any additional fees deemed necessary to Deposit Account 19-0743.

Respectfully submitted,

YOSHIHIRO KAWAOKA ET AL.,

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

(612) 373-6959

Date

October 10, 2003

By

Janet E Embretson

Reg. No. 39,665

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 10th day of October, 2003.

Name

Dawn M. Kote

Signature

Dawn M. Kote